



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,376	01/24/2002	Jeffrey U. Gafner	4470-00661	3902

26753 7590 01/22/2003

ANDRUS, SCEALES, STARKE & SAWALL, LLP
100 EAST WISCONSIN AVENUE, SUITE 1100
MILWAUKEE, WI 53202

EXAMINER

HALPERN, MARK

ART UNIT	PAPER NUMBER
----------	--------------

1731

DATE MAILED: 01/22/2003

2

Please find below and/or attached an Office communication concerning this application or proceeding.

AS-2

Office Action Summary

Application No.

10/056,376

Applicant(s)

GAFNER ET AL.

Examiner

Mark Halpern

Art Unit

1731

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 11-16, 25 and 26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9, 10 and 17-24 is/are rejected.
- 7) ☒ Claim(s) 7 and 8 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

- 1) Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-10, 17-24, drawn to an apparatus for decurling a running web, classified in class 162, subclass 271.
 - II. Claims 11-16, 25-26, drawn to a method for decurling a running web, classified in class 162, subclass 197.

The inventions are distinct, each from the other because of the following reasons:

Inventions II and I are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus may be used to practice another and materially another process, for example, sheet metal cutting.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

- 2) During a telephone conversation with Mr. J. Jochman on 1/10/2003, a provisional election was made without traverse to prosecute the invention of group I, drawn on claims 1-10, 17-24. Affirmation of this election must be made by applicant in replying to

Art Unit: 1731

this Office action. Claims 11-16, 25-26, are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

- 3) Claims 1-5, 9-10, 17-18, 21-24, are rejected under 35 U.S.C. 102(b) as being anticipated by Shelor (3,661,703).

Claims 1-2, 4-5, 9-10, 17, 21-24: Shelor discloses a decurling apparatus (Abstract) wherein web 12 travels between turn rollers 26 and 28. Drive roller 30 in a nip formation with roll 28 creates a zone of tension between said turn rollers 26 and 28. The tension is also maintained and varied by compensating roller 72. Decurling rollers 34 and 36 are positioned to engage the outer face of the web or the inner face of the web, by deflecting the web from a normal path of web travel through the tension zone. This is done by adjustment mechanism that includes drive means 40, motor 42, shaft 56 and compensation means 38, mounting brackets, among others. The decurling rolls are operative to move around the circumference of the compensating roll 72. The compensating roll 72 of Shelor, engaged with the inner face of the web, acts as the claimed rotatable pivot roll (col. 2, line 1 to col. 5, line 64, and Figures 1-4).

Claims 3, 18: the diameter of the compensating roll 72 is greater than the diameter of decurling roll 34 (Figures 2-4).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4) Claim 19, is rejected under 35 U.S.C. 103(a) as being unpatentable over Shelor. Shelor is applied as above for claim 18, Shelor fails to disclose the ratio of diameter of the decurler to the diameter of the pivot roll to be about 1:4. It would have been obvious, to one skilled in the art at the time the invention was made, that the ratio of diameter of the decurling roll 34 to the diameter of the compensating roll 72 be about 1:4, because Shelor does indicate that the diameter of decurling roll is substantially smaller than the diameter of roll 72 (col. 3, lines 10-24).

5) Claims 6, 20, are rejected under 35 U.S.C. 103(a) as being unpatentable over Shelor in view of Kishine (6,279,472).

Claim 6: Shelor is applied as above for claim 2, Shelor fails to disclose an infeed idler roll upstream of the brake roll and an outfield idler roll downstream of the pull roll. Kishine discloses a web curling prevention device (Abstract) that includes an infeed idler roll and an outfeed idler roll (Figure 1). It would have been obvious, to one skilled in the art at the time the invention was made, to combine the teachings of Shelor and

Art Unit: 1731

Kishine, because such a combination would stabilize and thus improve the curling prevention process in the design of Shelor.

Claim 20: the equipment defines a serpentine path of the web.

Allowable Subject Matter

6) Claims 7-8, are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The primary reason for indicating allowable subject matter is that cited prior art does not show an apparatus for decurling a running web delivered from a supply roll and fed to a downstream process operating at a line web tension, that includes an intermediate idler roll (claim 7); a second pivot roll (claim 8).

Conclusion

7) Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Halpern whose telephone number is 703-305-4522. The examiner can normally be reached on Mon-Fri, (9:00-5:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steven Griffin can be reached on 703-308-1164. The fax phone numbers

Application/Control Number: 10/056,376
Art Unit: 1731

Page 6

for the organization where this application or proceeding is assigned are 703-308-7718 for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0651.

A handwritten signature in black ink, appearing to read "M. Halpern", with a stylized, flowing script.

Mark Halpern
Patent Examiner
Art Unit 1731

January 15, 2003